

Remarks

The Office Action mailed March 8, 2006 has been carefully reviewed and the following remarks are made in consequence thereof.

Claims 1-20 are now pending in this application. It is respectfully submitted that the pending claims define allowable subject matter.

The rejection of claims 1, 4, 5, 7 and 12-14 under 35 U.S.C. § 102(b) as being anticipated by Ueda et al. (U.S. Patent No. 5,861,792) is respectfully traversed.

Applicants note the following with respect to the applicable law. As explained by the Federal Circuit, the requirements of Section 102, which is generally referred to as "anticipation", requires a disclosure in a single piece of prior art of each and every limitation of a claimed invention. Apple Computer, Inc. v. Articulate Systems, Inc., 57 USPQ2d 1057, 1061 (Fed. Cir. 2000). A finding of anticipation requires that the publication describe all of the elements of the claims arranged as in the patented device. C.R. Bard, Inc. v. M3 Systems, Inc., 48 USPQ2d 1225, 1320 (Fed. Cir. 1998).

Claim 1 recites a magnetic component comprising "a first monolithic core structure comprising a plurality of magnetic layers and at least one nonmagnetic layer separating one of said plurality of magnetic layers from another of said plurality of magnetic layers, and a first opening extending through said first core structure," and "a conductive element establishing a conductive path through said first opening, wherein said at least one nonmagnetic layer separates said conductive element from one of the magnetic layers."

Ueda et al. does not disclose the recitations of claim 1 arranged in the manner set forth in claim 1. In the Office Action, Ueda is cited for disclosing a monolithic core structure having a plurality of magnetic layers (15). As described and illustrated by Ueda et al., however, elements (15) are C-shaped iron cores formed as separate pieces and used in combination with a third I-shaped core (12) form a closed magnetic core. The core pieces (15) are assembled around a coil bobbin (7) with the core (12) in between. Clearly, Ueda does not disclose a monolithic core

structure but rather discloses a core structure having two separate C-shaped pieces and an I-shaped piece.

Moreover, the C-shaped core pieces (15) of Ueda et al. are certainly not fairly characterized as “layers” and any interpretation of “layers” that would encompass the C-shaped core pieces is respectfully submitted to be unreasonable.

In the Office Action, elements (16) of Ueda et al. is cited as corresponding to the recited non-magnetic layers in claim 1. The insulating sheets (16) of Ueda et al., however, clearly do not separate the core pieces (15) from one another. Ueda et al. describe that tapered surfaces (13) of the I-shaped core (12) mate with tapered surfaces (13a) on the legs of the C-shaped core pieces (15). *See, for example*, col. 4, lines 12-22 and Figs 2, 3a and 5. Clearly then, it is the I-shaped core piece (12) that separates the C-shaped core pieces (15) from one another, and not the insulating sheets (16).

For at least the reasons set forth above, it is respectfully submitted that Ueda et al. does not anticipate claim 1. Further, Ueda et al. is not suggestive of the invention of claim 1, and claim 1 is therefore submitted to be patentable over Ueda et al.

Claims 4, 5, 7 and 12-14 depend from independent claim 1, and when the recitations of claims 4, 5, 7 and 12-14 are considered in combination with the recitations of claim 1, claims 4, 5, 7 and 12-14 are likewise submitted to be patentable over Ueda et al.

Applicants therefore respectfully request the rejection of claims 2, 4, 5, 7 and 12-14 be withdrawn.

The rejection of claims 15-16 and 18 under 35 U.S.C. § 102(b) as being anticipated by Ibata et al. (JP0442513A) is respectfully traversed.

It is respectfully submitted that the present rejection based upon Ibata is procedurally improper. Applicants note that the Ibata et al. reference is a foreign language reference, and MPEP § 706.02 states that if a document is in a language other than English, and if the Examiner seeks to rely upon that document, a translation must be obtained so that record is clear as to the precise facts that the Examiner is relying upon in support of the rejection. A translation of the

Ibata et al. document has not been provided, and the necessary facts for the obviousness analysis under 35 U.S.C. § 103 are at present completely lacking on the record. It is respectfully submitted that the figures of Ibata are inadequate to determine whether the Ibata component meets the recitations of independent claim 15 and its dependent claims 16 and 18.

Notwithstanding the procedural aspects of the rejection, the abstract of the Ibata et al. reference, which is provided in English, suggests that the Ibata et al. reference teaches away from the invention by replacing an insulator layer (2) with a layer (5) having a mixture of magnetic and non-magnetic properties instead. Also, as depicted in Figure 1, the layer (2) does not separate the coil (3) from any other layer of the component (15) as claim 1 recites. Ibata et al. also appears to disclose a single E-shaped core structure in Figure 1, rather than a first core structure and a second core structure as claim 15 recites.

Claim 15 is therefore submitted to be patentable over Ibata et al., and when the recitations of claims 16 and 18 are considered in combination with the recitations of claim 15, claims 16 and 18 are likewise submitted to be patentable over Ibata et al.

Applicants therefore respectfully request the rejection of claims 15-16 and 18 be withdrawn.

The rejection of claims 2-3 under 35 U.S.C. § 103(a) as being unpatentable over Ueda et al. in view of Ishii et al. (U.S. Patent No. 6,433,664) is respectfully traversed.

Claims 2 and 3 depend from claim 1 that is submitted to be patentable over Ueda et al. for the reasons set forth above. Ishii et al. is not believed to add anything to the teaching of Ueda et al. with respect to the invention of claim 1, and does not cure the deficiencies of Ueda et al. with respect to the claimed invention. Ishii et al. simply describe a core (10) formed of a laminate of thin steel sheets. *See* col. 3, lines 2-4. Ishii et al., like Ueda et al., nowhere describe or suggest the monolithic core structure of claim 1 having at least one nonmagnetic layer as recited in claim 1.

Claim 1 is therefore submitted to be patentable over Ueda et al. in view of Ishii et al., and when the recitations of claims 2 and 3 are considered in combination with the recitations of claim 1, claims 2 and 3 are likewise submitted to be patentable over Ueda et al. in view of Ishii et al.

Applicants therefore respectfully request the rejection of claims 2-3 be withdrawn.

The rejection of claims 6 and 8-11 under 35 U.S.C. § 103(a) as being unpatentable over Ueda et al. in view of Ibata et al. is respectfully traversed.

The rejection relying upon Ibata et al. is procedurally improper for the reasons set forth above, and Applicants request that a complete English translation of the Ibata et al. reference be provided in support of the rejection. Alternatively, Applicants request that the rejection, to the extent that Ibata et al. is relied upon, be reconsidered and withdrawn.

Moreover, there is no apparent relation between the three piece core structure of Ueda et al. and the E-shaped core structure of Ibata et al. that would support the proposed combination of teachings. Applicants note that to combine the teaching of different prior art references a specific motivation to combine the teachings must be found in the prior art. The cited motivation to combine provided in the present Office Action, quoted from the abstract of Ibata et al., is “to provide small power loss when operating in high frequency of the component.” In response, Applicants note that the Office Action provides no explanation *why* or *how* modifying the Ibata et al. device with any feature of Ueda et al. would accomplish any benefit toward providing smaller power loss. Ueda et al. neither recognizes such problems nor discloses structure to address such problems.

Still further, the combination of Ueda et al. and Ibata et al. is not believed to be suggestive of the invention of claim 1 from which claims 6 and 8-11 depend. Claim 1 is submitted to be patentable over each of Ueda et al. and Ibata et al. for the reasons set forth above, and in combination the references collectively fail to teach all of the recitations of claim 1, and does not cure the deficiencies of Ueda et al. with respect to the claimed invention. Ishii et al., like Ueda et al., nowhere describe or suggest the monolithic core structure of claim 1 having at least one nonmagnetic layer as recited in claim 1.

Claim 1 is therefore submitted to be patentable over Ueda et al. in view of Ishii et al., and when the recitations of claims 6 and 8-11 are considered in combination with the recitations of claim 1, claims 6 and 8-11 are likewise submitted to be patentable over Ueda et al. in view of Ishii et al.

Applicants therefore respectfully request the rejection of claims 6 and 8-11 be withdrawn.

The rejection of claims 17 and 19-20 under 35 U.S.C. § 103(a) as being unpatentable over Ibata et al. in view of Ueda is respectfully traversed.

Applicants therefore respectfully request the rejection of claims 17 and 19-20 be withdrawn.

Applicants again respectfully submit that the rejection is improper and should be withdrawn unless a full translation of the Ibata et al. reference is provided to support the rejection. Additionally, neither Ibata et al. nor Ueda et al. disclose monolithic cores having first and second core structures. Ibata et al. disclose a single E-shaped core structure and Ueda disclose a single core structure assembled from three pieces.

Claim 15 is therefore submitted to be patentable over Ibtat et al. in view of Ueda et al., and when the recitations of claims 17 and 19-20 are considered in combination with the recitations of claim 1, claims 17 and 19-20 are likewise submitted to be patentable.

Applicants therefore respectfully request the rejection of claims 17 and 19-20 be withdrawn.

In view of the foregoing remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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